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PATENT APPLICATION
DOCKET NO. 10003227-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Robert E. Haines

CONFIRMATION NO.: 3806

SERIAL NO.: 09/738,795

GROUP ART UNIT: 2625

FILED: December 13, 2000

EXAMINER: Thierry L. Pham

SUBJECT: A Consumable Management Device, An Image Forming System,
And A Method Of Replenishing An Imaging Consumable

MAIL STOP APPEAL BRIEF - PATENTS
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SIR:

SUBSTITUTE REPLY BRIEF

Appellant respectfully asserts the rejections set forth in the Office Action dated March 8, 2006, hereinafter "Office Action" (and the rationale thereof repeated in pages 3-10 of the Examiner's Answer mailed February 8, 2007) are deficient for the reasons set for in the Brief of Appellant.

Appellant respectfully asserts that the rationale set forth at page 10+ of the Examiner's Answer fails to present proper rejections of the claims over the prior art for at least the below-mentioned reasons with respect to the argument sections of the Brief of Appellant.

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A. The 102 rejection of claims 1, 3-4, 7-9, 11, 13-14, 16-17, and 19-32 over Hayward.

At page 10 of the Examiner's Answer, the Office identifies the first designation as being included in the first message which the Office states is signals transmitted from an image forming device (e.g., printer) of Hayward to indicate conditions of the consumable part. Appellants have failed to uncover any teaching of any communication from the printer of Hayward including a first designation which identifies the imaging consumable. Hayward teaches sensing of the peripheral condition, however Appellants have failed to uncover any evidence that the sensing operation discloses the claimed first message including a first designation. Appellants have failed to uncover any teachings in Hayward that the sensing of the peripheral condition discloses a first message including a first designation. Hayward discloses a sensor 12 for sensing conditions of imaging consumables as recognized by the Office on page 10 of the Answer. There is no evidence that sensor 12 generates a message including a designation which identifies a consumable. One possible implementation is the peripheral condition is sensed via a dedicated line coupled with sensor 12 only configured to sense the condition of the predefined respective individual consumable and accordingly there is no need for the sensing of the peripheral condition to include a designation. In sum, *there is no teaching or other evidence of the record that the sensing of the peripheral condition of Hayward discloses a message including a designation which identifies the imaging consumable.* The above limitations are not disclosed nor suggested by the prior art and the 102 rejections are in error for at least this reason.

The Office at page 10 of the Answer alleges that computer 30 performs the claimed conversion of the first designation to a second designation identifying the imaging consumable. Appellant has failed to uncover any teaching in Fig. 7 or col. 7, lines 54 - col. 8, line 62 of Hayward of the *conversion of the first designation identifying the imaging consumable to a second designation identifying the image consumable as recited in the claims.* Appellants have electronically searched Hayward and failed to uncover any conversion of the claimed designation.

The Office further alleges on page 10 of the Answer that Hayward teaches the second message being converted from the first message by the host computer.

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Appellants have failed to uncover any teachings in Hayward of conversion of a message, and regardless, any such conversion of a *message* fails to teach the claimed conversion of the first designation identifying the imaging consumable of the first message to a second designation identifying the imaging consumable of the second message.

The claimed converting is not taught by the prior art and the claims are allowable for at least this additional reason.

Referring to the first bullet point on page 11 of the Examiner's Answer, the Examiner has apparently misinterpreted Section A of the Brief of Appellant. Appellant is not presenting an argument that the independent claims recite conversion of a part number. Appellant addressed the teachings of Hayward and noted that Hayward does teach a part number. Appellants position is that there is no teaching of conversion of a part number (or any other designation of a consumable) which may be fairly interpreted to disclose or suggest the claimed conversion of the first designation identifying the imaging consumable to a second designation identifying the imaging consumable as defined in the independent claims. Appellants respectfully assert that the 102 rejection is in error in view of the failure of Hayward to disclose the claimed conversion of the first designation to the second designation and accordingly the independent claims are allowable for at least this reason. Furthermore, Appellants note that respective dependent claims 5, 12, 18 clarify the designations as comprising part numbers. Appellant respectfully submits that it is clear that Appellant does not consider the independent claims to recite or to be limited to part numbers.

Appellant respectfully requests reversal of the rejection for at least the above-mentioned compelling reasons and the reasons set forth in the Brief of Appellant.

B. The 103 rejection of claims 2, 10 and 15 over Hayward and Hogge.

The claims recite in varying forms generation of a list including a plurality of second designations identifying a plurality of respective imaging consumables. Hayward discloses at col. 7, line 64 the filling out of the purchase order using a part number to be ordered and the provision of a single part number in the purchase order in Hayward fails to teach or suggest the claimed list including a plurality of

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second designations.

Appellants respectfully asserts that the Examiner's Answer also fails to establish that the claimed limitations are well known. The presence of two references is insufficient to establish that claim limitations are "well known" especially when the limitations which are alleged to be well known are properly considered in combination with the other claim limitations. Further, the citation of one patent 5,905,973 related to an online shopping system and one patent 7,039,602 related to allowing customers to customize a product by selecting components from lists of choices to provide a customized product (see e.g., col. 3, lines 22-33) do not demonstrate that the subject matter of the claims directed to replenishment of consumables are well known. Appellants again respectfully refer to the examples of MPEP 2144.03A of limitations which are considered well known, such as when new audio information is recorded then the old information is erased, when a heat requirement is varied it is well known to vary a flame, and use of a control in bacteriology. It is clear from these examples that proper reliance upon official notice occurs when the limitations alleged to be well known follow the prior art teachings (i.e., old data is erased when new data is recorded) which is not present in the subject rejection. MPEP 2144.03B (8th ed., rev. 5). Appellant respectfully submits that the reliance upon official notice goes beyond the limitations of MPEP 2144.03A and 2144.04E which make clear that *Official Notice is proper with respect to facts which are of notorious character and serve only to fill in the gaps in an insubstantial manner*. Appellant respectfully submits that entire positively recited limitations are not notorious and do not fill in gaps in an insubstantial manner. Appellant respectfully submits that the claimed limitations of the list including the plurality of second designations are not of notorious character. The claims recite devices, systems and methods for facilitating consumable replenishment in integrated systems for receiving a first designation and converting the first designation to a second designation. Appellant respectfully submits the use of the claimed list in combination with the other limitations of the respective claims is not notorious, merely gap filling or insubstantial.

To permit the Office to play lip service to the requirements of a proper prima facie 103 rejection by claiming positive limitations are "well known" is not authorized by the Federal Circuit. Appellant respectfully submits that the taking of

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Official Notice in the present rejection is an improper extension of Hayward directed towards the specific application of assisting a user with ordering a consumable and is not analogous to the examples of the MPEP wherein Official Notice is improper.

Appellants respectfully submit the Office has inappropriately disregarded the combination of limitations of the claims and improperly focused upon the limitations taken individually. The question under 35 U.S.C. §103 is not whether the differences between the prior art and the claims would have been obvious, but whether the claimed invention *as a whole* would have been obvious. *Stratoflex, Inc. vs. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871, 877 (Fed. Cir. 1983); M.P.E.P. §2141.02 I (8th ed. Rev. 5).

Appellant respectfully requests reversal of the rejection for at least the above-mentioned compelling reasons and the reasons set forth in the Brief of Appellant.

C. The 102 rejection of claims 3 and 16 over Hayward.

Appellants respectfully assert that the Examiner's Answer fails to establish that the reliance upon inherency to cure the deficiencies of Hayward is proper. Initially, the Office has failed to identify any teaching in Hayward that the purchase order of Hayward includes a quantity. Hayward demonstrates that the Examiner's allegation that "all purchase order must include a quantity" is false inasmuch as Hayward discloses purchase orders which do not specify quantity and the part is still ordered and received per col. 8, lines 24-25. The Office has failed to address the existence of alternatives as set forth in Section C of the Brief of Appellant wherein the buyer and seller may agree on default quantities to be ordered upon the sending of a purchase order which is void of any specification of quantity. This existence of alternatives shows that the allegedly inherent characteristics do not necessarily flow from the teachings of the applied prior art and the reliance upon inherency is improper under *Ex Parte Levy* and MPEP 2112 IV set forth in the Brief of Appellant.

Referring to the dictionary.com definition for "Purchase Order" accompanying the Examiner's Answer, Appellant notes that such information is presented for the first time after a lengthy prosecution of the claims. The Examiner has cited no authority for the position that a dictionary definition of one example of a term

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(purchase order) may be considered to alter the teachings of the prior art reference to include the example definition reciting quantity when the reference is void of any quantity specification. The single definition does not establish that the clearly defined purchase order of Hayward lacking quantity must include quantity information.

Appellant respectfully requests reversal of the rejection for at least the above-mentioned compelling reasons and the reasons set forth in the Brief of Appellant.

D. The 102 rejection of claims 4, 11, and 17 over Hayward.

The claims recite in varying forms that the *second message comprising an email message and the second designation is included as an attachment of the email*. The teachings of col. 8, lines 5-25 of Hayward merely disclose sending a purchase order via email. Emails may include information in the body of an email or as an attachment to the email. The Office has failed to identify any teachings in Hayward that the purchase order is sent as an attachment to an email. Furthermore, the Office has failed to identify any teachings in the prior art that information in the body of an email is considered to be an attachment to the email. Appellants respectfully submit that the Office has tortured the meaning of attachment to cure the deficiencies of the teachings of Hayward. Hayward is void of any teaching or suggestion of the purchase order being an attachment to an email. Furthermore, the mere disclosure of usage of an email module in Hayward fails to disclose the specifically claimed limitation that the second designation is included as an attachment of the email.

The Office states that Appellant in the claims does not specify how an attachment is attached to the email message. In response, Appellant is not claiming how the attachment is attached but rather the specific claimed combination that the second designation is included as an attachment to an email which is not taught by the prior art.

Positively-recited limitations of the claims are not disclosed nor suggested by the prior art and the Appellants respectfully submit the Office has failed to establish a proper anticipation rejection for at least this reason.

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E. The 103 rejection of claims 5, 12 and 18 over Hayward and Hogge.

Appellant respectfully submits that the Office has failed to present a proper prima facie 103 rejection. For a proper 103 rejection, the examiner must establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Reasons for the decision to combine references must be articulated. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). The Examiner must make requisite findings, based on evidence of record, and also explain the reasoning by which the findings are deemed to support the examiner's conclusion. These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Appellant respectfully asserts that the Examiner, in the rationale for combining the references, addresses or provides a solution for a problem which is not present and has improperly relied upon Appellant's teachings. The Office at page 13 of the Examiner's Answer reiterates the rationale of the Office Action for combining the teachings of Hogge directed towards converting part numbers with Hayward. However, Hayward fails to teach utilization of multiple part numbering systems wherein a solution of corresponding part numbers between the disparate systems would be relevant. Hayward discloses at col. 8, lines 48 an integrated system with no mention of disparate part systems or encountering problems with respect thereto. Hayward at col. 8, lines 48+ teaches the integrated system wherein the server 40 has pre-arranged contracts with office supply retailers and mail order houses such that server 40 is kept aware of inventory on hand and can confirm availability before sending the shipment order to the retailer. Hayward at col. 7, lines 63+ states that a purchaser order screen is filled out with a part number to be ordered based on the sensed peripheral condition and the order may be forwarded to a supplier at col. 8, lines 46+. Appellant has failed to locate any teachings of deficiencies with respect to the usage of the part numbers of the purchase orders of Hayward adequately identifying the parts to be ordered. Accordingly, Hayward already teaches operable arrangements with multiple suppliers/retailers and there is no reasonable rationale for the combination proposed by the Office apart from improper reliance upon Appellant's disclosure.

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The Office also misconstrues the teachings of Hayward. At the first full paragraph on page 13 of the Answer, the Office alleges that Hayward teaches a manufacturer part number. Appellant has electronically searched and failed to uncover any teaching of a manufacturer part number in Hayward. Appellant has failed to uncover any teachings in Hayward that the system of Hayward uses customer or manufacturer part numbers. Accordingly, even if conversion between customer and manufacturer part numbers is considered to be well known (which Appellant submits is improper for the below-mentioned reasons) such teachings are inapplicable to arrangements such as Hayward which are void of using plural numbering systems in the first instance where any part conversion would be beneficial. The conversion is irrelevant and non-sensical to the arrangement of Hayward void of plural part numbering systems.

At page 13 of the Examiner's Answer, the Office states that use of the Hogge method ensures the right part is ordered from the vendor. Appellant disagrees and submit that modifying Hayward per Hogge is nonsensical in view of Hayward using a single common part number and there are no problems with respect to correctly identifying parts.

Appellant further respectfully submits that the claimed conversion is not well known and Appellant traverses any reliance upon official notice in support of the 103 rejection in accordance with MPEP 2144.03A (8th ed., rev. 5). Appellant respectfully submits that the citation of a single reference Hogge fails to establish that the limitations explicitly reciting conversion from a manufacturer part number to a customer part number are well known especially when properly considered in combination with the other limitations and Hayward is void of teachings regarding use of plural part numbering systems. The question under 35 U.S.C. §103 is not whether the differences between the prior art and the claims would have been obvious, but whether the claimed invention *as a whole* would have been obvious. *Stratoflex, Inc. vs. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871, 877 (Fed. Cir. 1983); M.P.E.P. §2141.02 I (8th ed. Rev. 5). The Examiner is also reminded that claims are analyzed in the context of the combination of the various separately stated limitations of the claimed invention as a whole, and not with respect to the limitations individually. MPEP 2141.02I (8th ed., rev. 5).

Appellant respectfully submit that there is insufficient factual basis to
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combine the disparate teachings of Hogge of no concern to the disclosed arrangements of Hayward and the Office has failed to establish a proper prima facie 103 rejection for at least this reason. The changing of the rationale of the 103 rejection for the first time in the Examiner's Answer to rely upon official notice illustrates the tenuous and erroneous nature of the rejection. Appellant respectfully submits that teachings of Hogge directed towards arrangements of no applicability of Hayward are not in same vein of the examples of the MPEP regarding proper reliance upon official notice (e.g., examples of MPEP 2144.03A of limitations which are considered well known, such as when new audio information is recorded then the old information is erased, when a heat requirement is varied it is well known to vary a flame, and use of a control in bacteriology).

The Appellants respectfully submit the Office has failed to establish a proper obviousness rejection for at least the reasons presented herein and the Brief of Appellant.

F. The 102 rejection of claims 8 and 20 over Hayward.

Appellant respectfully submits the teachings of the Summary of Invention section of Hayward relied upon in the Examiner's Answer fail to cure the deficiencies of col. 8 of Hayward as previously relied upon by the Office prior to the Examiner's Answer in support of the rejection.

As is clear from the teachings of col. 8, lines 4+ of Hayward, the timing of the communication of the purchase order in Hayward *is chosen by the user and is not disclosed at a predetermined moment in time.*

Further, the teachings of the Summary of Invention of col. 1, lines 50-62 of Hayward fail to teach the claimed limitations. The teachings of lines 50-62 of col. 1 of Hayward are not related to time and do not otherwise teach communication of the second message at a predetermined moment in time as claimed.

Positively-recited limitations of the claims are not disclosed by the prior art and Appellant respectfully requests reversal of the rejection for at least the above-mentioned compelling reasons and the reasons set forth in the Brief of Appellant.

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G. The 102 rejection of claims 21, 23 and 25 over Hayward.

Referring to the last paragraph of page 14 of the Examiner's Answer, Appellant respectfully submit that the "conditions" are disclosed as conditions and fail to disclose or suggest the claimed designation identifying the consumable. The sensor output of Hayward is disclosed as being indicative of conditions with no teaching of identification of a consumable whatsoever. The Office further at page 15 of the Examiner's Answer alleges that the manual side shown in Fig. 2 of Hayward teaches a first designation is generated from printer 10 and transmitted to PC 30. Fig. 2 is void of any teaching of the claimed first designation or that a designation is generated by printer 10 and transmitted to PC 30.

The Office further states that col. 9, lines 13-17 of Hayward teach a first designation. Hayward at col. 9, lines 13-17 merely state that the listed components may be external of the marking apparatus 8, may interrogate the consumable component for information, and may communicate information to server 40 void of mentioning any teaching of the claimed designations identifying a consumable or a second designation is forwarded to a first entity as claimed.

Positively-recited limitations of the claims are not disclosed by the prior art and Appellant respectfully requests reversal of the rejection for at least the above-mentioned compelling reasons and the reasons set forth in the Brief of Appellant.

H. The 102 rejection of claims 22, 24 and 26 over Hayward.

At page 16 of the Examiner's Answer, the Office relies upon inherency for the first time during the prosecution of the present application in support of the rejection. This late argument is improper and the rejection of the claims is improper.

Proper reliance upon inherency requires that the allegedly inherent limitations necessarily flow from the teachings of the prior art. The Office without any explanation or evidence baldly states that a supplier/vendor/manufacture will not recognize the first designation because the first designation is not a purchase order. The Office cites no authority for the position that it is impossible for a supplier/vendor/manufacture to identify a consumable absent the use of a purchase order. In addition, the Office cites no support for the bald sweeping statement that a supplier/vendor/manufacture is only designed to recognize purchase orders. The

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claimed limitations do not necessarily flow from the teachings of the prior art and the reliance upon inherency is improper for at least this reason under *Ex Parte Levy* and MPEP 2112 IV set forth in the Brief of Appellant.

Positively-recited limitations of the claims are not disclosed by the prior art and Appellant respectfully requests reversal of the rejection for at least the above-mentioned compelling reasons and the reasons set forth in the Brief of Appellant.

I. The 102 rejection of claims 27, 29 and 31 over Hayward.

For the first time during the prosecution of the present application, the Office identifies teachings in col. 5, lines 5-12 of Hayward in the Examiner's Answer in support of the 102 rejection of the claims. The teachings of col. 5 fail to teach or suggest the claimed limitations. In particular, the teachings of col. 5 merely state that conditions in the machine 10 may indicate a need to replace a consumable. Without association to a predetermined status, the teachings further state that the sensed indicia *from registration* may be used to identify and order a consumable item. The teachings of col. 5 fail to disclose *forwarding or communication of the second message responsive to the predetermined status* as claimed.

Further, the teachings of Hayward at col. 9, lines 20-32 state that modem 34, connection 36 or server 40 may communicate the information regarding the condition of the consumable component and automatically initiate an order. However, there is no teaching that the communication is initiated responsive to the predetermined status. The teachings at col. 9 further list threshold conditions but fail to teach that communication of the claimed second message occurs responsive to any predetermined status of the imaging consumable. The Office has in relying upon cols. 5 and 9 in support of the rejection made inferences that Hayward teaches ordering *responsive to* status. The inferences are improper since the claimed limitations of forwarding or communicating the second message responsive to the predetermined status are not taught in Hayward.

Positively-recited limitations of the claims are not disclosed by the prior art and Appellant respectfully requests reversal of the rejection for at least the above-mentioned compelling reasons and the reasons set forth in the Brief of Appellant.

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J. Conclusion

Reversal of the rejections of the claims and allowance of the claims is respectfully requested for at least the reasons discussed herein and the reasons set forth in the Brief of Appellant.

Respectfully submitted,

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Dated: 3/13/07

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